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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/678,034
Filing Date: September 30, 2003
Appellant(s): NGUYEN ET AL.

Patrick R. Jewik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/12/07 appealing from the Office action
mailed 9/19/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 1-5, 7-9, 59, 63, 64 are rejected as being unpatentable over McGauley et al (US 5,899,998), in further view of Hanna et al (US 2004/0141661 A1), and claims 6, 60, 62, 65, 68 are rejected as being unpatentable over McGauley et al (US 5,899,998), in further view of Hanna et al (US 2004/0141661 A1), and further in view of Sesek (US 2003/0093344 A1).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,899,998	MCGAULEY et al	5-1999
2004/0141661	HANNA et al	7-2004
5,915,019	GINTER et al	6-1999
2003/0093344	SESEK	5-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-9, 59, 63, 64, are rejected under 35 U.S.C. 103(a) as being unpatentable over McGauley et al (US 5,899,998), in further view of Hanna et al (US 2004/0141661 A1).

As per claims 1, 59, 63, 64, McGauley et al discloses:

a point of service device having associated therewith a plurality of rules, (Col. 4, lines 61-65, point of service stations utilizing rules); and

a portable device having associated therewith a plurality of rules/wherein the portable device operates using a contactless mode of operation, (Col. 5, lines 27-30 and Fig. 7, rules set used to handle communication updates between portable data carrier and point of service stations, since the data carrier is portable, it is in contactless mode when carried around);

wherein the portable device and the point of service device use their associated plurality of rules...to determine an outcome for a...transaction/determining an outcome... /wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to request the service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules

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associated with the service provider system/wherein the plurality of meta-rules associated with the point of service device includes a meta-rule for replacing at least one rule in the plurality of rules associated with the point of service device with another rule, (Abstract, lines 6-16, interaction between portable device and point of service ties distributed databases together where database systems then use update object to distribute data as a result of a transaction as shown in col. 3, line 66-col. 4, line 10, also shows rule sets are applied to portable device and point of sale);

McGauley et al fails to disclose a plurality of meta-rules/a purchase transaction/wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request a service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system/if the outcome can not be determined..., but does disclose a second processing rules set in Col. 27, lines 17-22. In this case, this second processing rules set is applied to information stored in the database, where this type of information is effected by transactions that occur between portable data carriers, and point-of-service stations as shown in the abstract, lines 6-9, and in turn, the administrative services, and does disclose a system that distributes medical information.

However, Hanna et al shows a system that aims to define formats for electronic data interchange in health care environments such as patient medical records as shown in paragraph [0009], lines 1-8, and also shows a medical distribution and retrieval system that shows images are purchased in paragraph [0013], lines 7-10, that discloses:

A plurality of meta-rules, (Page 15, line 58-Page 16, line10, shows that stored rules are evaluated and the image is then stored according to a rule which was evaluated as satisfied by having parameters in a stored rule compared with information in the associated metadata, in this case, the rules are meta rules since they are associated with metadata);

wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request the service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system/if the outcome can not be determined..., (Page 16, lines 4-5, shows rules are changed to reflect a change in the image storage policy after evaluating that stored rule, in this case, if the stored rule is evaluated and not satisfied, the rules are changed).

Hanna et al discloses these limitations in an analogous art for the purpose of showing that rules directly associated with meta rules are applied for the purchase of

medical image data, so that if there is a change in the image storage policy of the health care enterprise, the evaluate rule will then not be satisfied, and the rule will therefore have to be changed.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply meta-rules to determine whether one or more of the plurality of rules can be altered with the motivation of keeping rules updated according to system change in a system for purchasing medical image data.

As per claims 2, 3, McGauley et al fails to disclose the following, but does disclose a second processing rules set in Col. 27, lines 17-22. In this case, this second processing rules set is applied to information stored in the database, where this type of information is effected by transactions that occur between portable data carriers, and point-of-service stations as shown in the abstract, lines 6-9, and in turn, the administrative services).

However, Hanna discloses:

A network gateway having associated therewith a plurality of rules and a plurality of meta rules; wherein if the portable device and the point of service device are unable to determine the outcome, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request the network gateway to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the network gateway/if the outcome cannot be determined using the plurality of rules

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associated with the point of service device, using the plurality of meta-rules associated with the point of service device to either determine whether one or more of the plurality of rules associated with the point of service device can be altered locally in order to determine the outcome or request a network gateway to help determine the outcome using a plurality of rules and a plurality of meta-rules associated with the network gateway/wherein if the network gateway is unable to determine the outcome using its associated plurality of rules, the network gateway uses its associated plurality of meta-rules to either determine whether one or more of its associated plurality of rules can be altered locally in order to determine the outcome or request a second network gateway or a first service provider to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system, (Page 16, lines 4-5, shows rules are changed to reflect a change in the image storage policy after evaluating that stored rule, in this case, if the stored rule is evaluated and not satisfied, the rules are changed. In this case, rules are applied through an intelligent image management system connected to devices located throughout a health care enterprise through a high speed serial communication network, which utilizes bridges that may connect the intranet to the Internet to communicate with remote devices such as personal computers located in a physician's office or home as shown in paragraph [0030], lines 8-11, which represents the network gateway, since a network gateway is no more than software or hardware that enables communication between computer networks that use different communications protocols).

Hanna et al discloses these limitations in an analogous art for the purpose of showing that rules directly associated with meta rules are applied so that if there is a change in the image storage policy of the health care enterprise, the evaluate rule will then not be satisfied, and the rule will therefore have to be changed.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply meta-rules to determine whether one or more of the plurality of rules can be altered with the motivation of keeping rules updated according to system change.

As per claims 4, 5, McGauley et al discloses:

wherein the point of service device uses historical...transaction information to update the plurality of rules and the plurality of meta-rules associated with the portable device in order to render processing of...transactions more efficient/wherein the service provider system uses historical...transaction information to update the plurality of rules and the plurality of meta-rules associated respectively with the portable device and the point of service device in order to render processing of...transactions more efficient/wherein the first node uses historical...transaction information to update the plurality of rules and the plurality of meta-rules associated with a node having a node order that is equal to or lower than that of the first noted in order to render processing of ...transactions more efficient ,(col. 20, lines 35-38, automatically store historic record as an update object is routed, therefore each time an update occurs, the historic information is part of the stored information and is therefore accessed when addition al

updates occur, also, both the portable device and the point of service are updated concurrently as shown in col. 16, lines 36-37).

As per claim 7, McGauley et al discloses:

Wherein the system is implemented using software, hardware or a combination of both, (col. 6, lines 19-21, hardware and software).

As per claim 8, McGauley et al discloses:

wherein the portable device includes a smart card, a memory stick, a dongle, a personal digital assistant, a cellular phone and a pager, (Abstract, lines 4-5, smart card).

As per claim 9, McGauley et al discloses:

wherein the point of service device includes a personal computer, a point of sale device, a kiosk, an automatic teller machine and a cellular phone, (col. 6, lines 21-22, personal computer).

As per claim 10, McGauley et al discloses:

a service provider system having associated therewith a plurality of rules, (col. 4, lines 61-65, administrative service systems utilizing rules);

a network gateway having associated therewith a plurality of rules, (Paragraph [0030], lines 8-11, shows Bridges, which represents the network gateway, since a network gateway is no more than software or hardware that enables communication between computer networks that use different communications protocols. In this case, rules are applied through an intelligent image management system connected to devices located throughout a health care enterprise through a high speed serial communication network, which utilizes bridges that may connect the intranet to the

Internet to communicate with remote devices such as personal computers located in a physician's office or home as shown); and

a portable device having associated therewith a plurality of rules, (Col. 5, lines 27-30 and Fig. 7, rules set used to handle communication updates between portable data carrier and point of service stations);

wherein the portable device uses its associated plurality of rules to determine an outcome for a...transaction, (Abstract, lines 6-16, interaction between portable device and point of service ties distributed databases together where database systems then use update object to distribute data as a result of a transaction as shown in col. 3, line 66-col. 4, line 10, also shows rule sets are applied to portable device and point of sale);

McGauley et al fails to disclose a plurality of meta-rules/wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request the service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system/if the outcome can not be determined..., but does disclose a second processing rules set in Col. 27, lines 17-22. In this case, this second processing rules set is applied to information stored in the database, where this type of information is effected by transactions that occur between portable data carriers, and point-of-

service stations as shown in the abstract, lines 6-9, and in turn, the administrative services.

However, Hanna et al shows a system that aims to define formats for electronic data interchange in health care environments such as patient medical records as shown in paragraph [0009], lines 1-8, and also shows a medical distribution and retrieval system that shows images are purchased in paragraph [0013], lines 7-10 that discloses:

A plurality of meta-rules, (Page 15, line 58-Page 16, line10, shows that stored rules are evaluated and the image is then stored according to a rule which was evaluated as satisfied by having parameters in a stored rule compared with information in the associated metadata, in this case, the rules are meta rules since they are associated with metadata);

wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request the service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system/if the outcome can not be determined..., (Page 16, lines 4-5, shows rules are changed to reflect a change in the image storage policy after evaluating that stored rule, in this case, if the stored rule is evaluated and not satisfied, the rules are changed).

Hanna et al discloses these limitations in an analogous art for the purpose of showing that rules directly associated with meta rules are applied so that if there is a change in the image storage policy of the health care enterprise, the evaluate rule will then not be satisfied, and the rule will therefore have to be changed.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply meta-rules to determine whether one or more of the plurality of rules can be altered with the motivation of keeping rules updated according to system change.

Claims 6, 60, 62, 65, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGauley et al (US 5,899,998), and further in view of Hanna et al (US 2004/0141661 A1), and further in view of Sesek (US 2003/0093344 A1).

As per claim 6, McGauley et al discloses:

A service provider system..., (Col. 4, lines 61-65, group of point of service stations);

a point of service device having associated therewith a plurality of rules..., (Col. 4, lines 61-65, point of service stations utilizing rules); and

a portable device having associated therewith a plurality of rules... (Col. 5, lines 27-30 and Fig. 7, rules set used to handle communication updates between portable data carrier and point of service stations);

wherein the portable device and the point of service device use their associated plurality of rules...to determine an outcome for a...transaction/determining an

outcome... (Abstract, lines 6-16, interaction between portable device and point of service ties distributed databases together where database systems then use update object to distribute data as a result of a transaction as shown in col. 3, line 66-col. 4, line 10, also shows rule sets are applied to portable device and point of sale);

McGauley et al fails to disclose a plurality of meta-rules/a purchase transaction/wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request a service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system/if the outcome can not be determined..., but does disclose a second processing rules set in Col. 27, lines 17-22. In this case, this second processing rules set is applied to information stored in the database, where this type of information is effected by transactions that occur between portable data carriers, and point-of-service stations as shown in the abstract, lines 6-9, and in turn, the administrative services, and does disclose a system that distributes medical information.

However, Hanna et al shows a system that aims to define formats for electronic data interchange in health care environments such as patient medical records as shown in paragraph [0009], lines 1-8, and also shows a medical distribution and retrieval

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system that shows images are purchased in paragraph [0013], lines 7-10, that discloses:

A plurality of meta-rules, (Page 15, line 58-Page 16, line 10, shows that stored rules are evaluated and the image is then stored according to a rule which was evaluated as satisfied by having parameters in a stored rule compared with information in the associated metadata, in this case, the rules are meta rules since they are associated with metadata);

wherein if the portable device and the point of service device are unable to determine the outcome for the purchase transaction, the point of service device uses its associated plurality of meta-rules to either determine whether one or more of the plurality of rules associated with either the portable device or the point of service device can be altered locally in order to determine the outcome or request the service provider system to help determine the outcome using the plurality of rules and the plurality of meta-rules associated with the service provider system/if the outcome can not be determined..., (Page 16, lines 4-5, shows rules are changed to reflect a change in the image storage policy after evaluating that stored rule, in this case, if the stored rule is evaluated and not satisfied, the rules are changed).

Hanna et al discloses these limitations in an analogous art for the purpose of showing that rules directly associated with meta rules are applied for the purchase of medical image data, so that if there is a change in the image storage policy of the health care enterprise, the evaluate rule will then not be satisfied, and the rule will therefore have to be changed.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to apply meta-rules to determine whether one or more of the plurality of rules can be altered with the motivation of keeping rules updated according to system change in a system for purchasing medical image data.

McGauley et al also fails to disclose wherein the outcome for the transaction includes a price, but does disclose a distributed database network system provide cost-effective access to databases in col. 1, lines 41-43.

However, Hanna et al discloses:

wherein the outcome for the transaction includes a price, (paragraph [0014], lines 1-10, shows that according to need, business decisions are made regarding images that will be stored faster, higher cost devices). Hanna et al discloses this limitation in an analogous art for the purpose of showing that a price must be paid for storage ability.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention fort the outcome for a transaction to include price with the motivation of implementing a cost with a transactional service.

Both McGauley et al, and Hanna et al fail to disclose the following, but McGauley et al does disclose a distributed database network system in col. 2, lines 31-34.

However, Sesek discloses a method and system for compensating a recipient for obtaining and printing an electronic document for the purchase of an advertised product, which may take form of a check or a coupon:

Wherein the point of service device is a vending machine, (paragraph [0015], lines 6-12, in this case, the audio file or movie is the vended content and the user's PC serves as the vending machine since it runs on the PC). Seseek discloses this limitation in an analogous art for the purpose of showing that audio files or movies that are to be purchased by a user can be obtained through a machine environment.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the point of service device to be a vending machine with the motivation of showing that product distribution can take place through vendor transactions.

As per claims 60, 65, both McGauley et al, and Hanna et al fail to disclose the following, but McGauley et al does disclose a distributed database network system in col. 2, lines 31-34.

However, Seseek discloses a method and system for compensating a recipient for obtaining and printing an electronic document for the purchase of an advertised product, which may take form of a check or a coupon:

Wherein the point of service device is a vending machine, (paragraph [0015], lines 6-12, in this case, the audio file or movie is the vended content and the user's PC serves as the vending machine since it runs on the PC). Seseek discloses this limitation in an analogous art for the purpose of showing that audio files or movies that are to be purchased by a user can be obtained through a machine environment.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the point of service device to be a vending machine with the

motivation of showing that product distribution can take place through vendor transactions.

As per claim 62, 68, both McGauley et al, and Hanna et al fail to disclose the following, but McGauley et al does disclose a distributed database network system in col. 2, lines 31-34.

However, Sesek discloses a method and system for compensating a recipient for obtaining and printing an electronic document for the purchase of an advertised product, which may take form of a check or a coupon:

Wherein the outcome is determined using a price computation process, (paragraph [0023], lines 9-14, compensation value calculated and applied based on print content). Sesek discloses this limitation in an analogous art for the purpose of showing that compensation is based on print content.

It would have been obvious to one of ordinary skill in the art for the outcome to be determined using a price computation process with the motivation of obtaining a reward value based on the value of the purchased product.

(10) Response to Argument

As per claim 1, appellant argues that McGauley et al and Hanna et al do not render this claim obvious. Specifically, appellant argues that prior art does not disclose: "wherein the portable device and the point of service device use their associated plurality of rules and plurality of meta-rules to determine an outcome for a purchase transaction".

However, the *combination* of McGauley and Hanna et al disclose a "purchase transaction" whose outcome is determined using rules and meta-rules. First, McGauley

discloses a second processing rule set applied to information stored in the database. Hanna et al further enhances the McGauley reference to teach the claim limitation since Hanna et al discloses a system that aims to define formats for electronic data interchange as shown in paragraph [0009], lines 1-8, where meta-rules are shown on Page 15, line 58-Page 16, line 10 through the disclosure of stored rules being evaluated and the image then being stored according to a rule which was evaluated as satisfied by having parameters in a stored rule compared with information in the associated metadata. In addition, Hanna et al also discloses image purchase in paragraph [0013], lines 7-10. It is true that Hanna et al discloses the cost to store images in a storage device, however, this cost is also inclusive in a cost to purchase the image since, in order to retrieve the image, a storage device is purchased, and therefore, a purchase costs is spent to retrieve the image, thereby making it a purchase transaction.

Appellant also argues that there is no motivation to combine the McGauley et al, Hanna et al, and Sesek references. However, KSR forecloses Appellant's argument that a specific teaching is required for a finding of obviousness, *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. The claims of the present invention recite combinations which only unite old elements with no change in their respective functions and which yield predictable results. Thus, the claimed subject matter likely would have been obvious under *KSR*.

Appellant also argues that Improper hindsight was used to combine McGauley et al., Hanna et al. and Sesek et al. However, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning.

But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As per independent claim 6, this claim has similar language as independent claim 1, and many of the above arguments with respect to independent claim 1 apply to independent claim 6. Appellant also argues that none of the cited references discloses a "vending machine" the elements of these claims are not taught or suggested by prior art used. Appellant also argues that defined by Webster's Ninth Collegiate Dictionary, the word "vend" means "to dispose of something by sale." However, it is the combination of McGauley et al., Hanna et al. and Sesek et al that renders this limitation obvious. Specifically, Sesek discloses in paragraph [0015], lines 6-12, that the print content may represent an audio file or movie. In this case, the audio file or movie represents the vended content since it is shown that there is compensation or payment for obtaining and/or printing the print content, and therefore, the user's PC serves as the vending machine since the audio file/movies run on the PC. In this case, Sesek renders having audio files or movies that are to be purchased by a user, obtained through a machine environment obvious.

In addition, appellant argues that one would not have been motivated to modify McGauley et al to use a vending machine to dispense medical records since medical records are confidential. However, a medical record is an electronic document, and as taught in Sesek, can be retrieved by purchasing them. In McGauley et al, even though

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the medical records are confidential, they can still be retrieved electronically by the patient for whom they belong to, and therefore, one would have been motivated to modify McGauley et al to use a vending machine for patients who may come into a hospital and request their records through the hospital's computerized database.

As per claim 64, appellant argues that prior art fails to teach that the portable device operates using a "contactless" mode of operation. However, Col. 5, lines 27-30 and Fig. 7 of McGauley et al discloses that a rules set used to handle communication updates between portable data carrier and point of service stations, and in this case, since the data carrier is portable, it is in contactless mode when carried around.

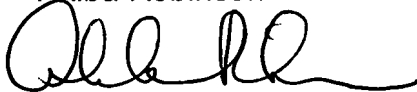
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Akiba Robinson



Conferees:

Vincent Millin



Igor Borissov

